UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,023	01/10/2002	Toshihiro Morita	450101-02844	4611

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EXAMINER
CHEN, TE Y

ART UNIT	PAPER NUMBER
2161	

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/889,023	MORITA ET AL.
	Examiner	Art Unit	
	Susan Y. Chen	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 September 2005*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *41-43 and 48-66* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *41-43 and 48-66* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date *8/29/05*.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Amendment

Claim Status

This office action is in response to the amendment filed on 09/15/2005. Claim 41-

43, 48-66 are pending for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 41-43 and 48-66, are rejected under 35 U.S.C. 103(a) as being

unpatentable over U.S. Patent No. 6,412,012 issued to Bieganski et al. (hereinafter

referred as '012 Bieganski) in view of U.S. Patent No. 6,959,288 issued to Medina et al.

(hereinafter referred as '288 Medina).

Claims 41, 48, 53, 55, 60, and 62:

Bieganski discloses an information processing system as claimed [e.g.,

Fig. 1] comprising:

- means for recording usage history data and the related data

  recorded in the recording means based on the filtering data [e.g.,

the CPU (102, Fig. 1) can coupled to the memory system (104,

Fig. 1) and the secondary storage(108 of Fig. 1) to log history data

indicative of usage history of the group of contents. For example,

the data being stored in the History Set (203), Fig. 2; or the

customer's behavior data recorded at a shopping set being

specified at col. 8, lines 7-8; or the Purchased Items associated to

a particular user's Transaction or the total number of Transaction

being purchased of the unit 900, Fig(s). 9; the Recommendation

engine (600, Fig. 14; col. 14, lines 31-33)];

- means for computing per each of the contents a weight related to

a number of checkout from the history data and the related data

recorded in the recording means based on the filtering data [e.g.,

the compatibility modifier (200, Fig. 2) can accept a stored number

of checkout (or the number of times each item was purchased,

Fig. 9) per each of the contents from the history data on a filtering

rule specified by a marketer or customer or the processing of

recommendation engine itself (col. 9, lines 63-49) to compute a

weight related to the number of checkout (the steps 752-756, Fig.

7A)];

- means for selecting a content from a group of contents based on

weight computed by the computing means [e.g., the user interface

adapter coupled to the Input Device (114, 118, Fig 1) can be used

to select the modified recommendation set based on weight

computed by the compatibility modifier (Fig. 5; Fig. 6; col. 13, line

21 - col. 14, line 14; col. 14, line 31-col. 15, line 2)];

- means for display a list of at least titles in the information related

    to the contents selected by the selecting means [e.g., the Display

    Adapter (112, Fig. 1) coupled to the Display Device (116, Fig. 1)

    can display a list of recommended books selected by the book

    reviewer (col. 7, lines 49-54)].

'012 Bieganski did not specifically disclose that a checkout occurs when contents

are copied from the information processor to a separate device in accordance with

usage rule data which includes rules on the number of checkouts for each of the

contents.

However, '288 Medina discloses an information processing system comprising a

checkout occurs when contents are copied from the information processor to a separate

device in accordance with usage rule data which includes rules on the number of

checkouts for each of the contents [e.g., '288 Medina: the end user of the devices (109,

Fig. 1D) activates the player application (195, Fig. 1D) to copy (or checkout) songs to

CD (col. 93, line 65) according to the usage rules tracked by the clearing house (105,

Fig. 1C) or the content providers (101, Fig. 1A), wherein the rules comprise the number

of checkout for each of the contents (col. 90, lines 5-60); The player Application 195

section, col. 87, line 25 – col. 91, line 10; Fig.(s) 15 -16 and associated texts].

'012 Bieganski and '288 Medina are both in a network information processing system comprising user interface to perform checkout operations, therefore, with the teachings of Bieganski and Medina in front of him/her, it would have been obvious for one of the ordinary skill person in the art at the time the invention was made to modify Bieganski's system with the technique taught by Medina to provide a checkout operation that occurs when contents are copied from the information processor to a separate device in accordance with usage rule data which includes rules on the number of checkouts for each of the contents, because by doing so, as suggested by Medina the combined system will provides a standard for creating digital players on end-user device that allows an end user to manage of a local library of digital contents no other than what was purchased [e.g., col. 5, lines 39-53].

As to claims 42, 49, 51-52, 54, 56, 58-59, 61, 63, and 65-66:

Except all the features recited in claims 41, 48, 53, 55, 60, and 62, the combined system of Bieganski and Medina further discloses that the system comprising means to computes per each of the contents as weight for a period for which the content has been checked out or for the genre of the content or for playing time of the content [e.g., '288 Medina: col. 13, lines 1-9; col. 93, line15].

As to claims 43, 50, 57 and 64:

Except all the features recited in claims 41, 48, 53, 55, 60, and 62, the combined

system of Bieganski and Medina further discloses that the system comprising means for

adding new filtering data [e.g., '288 Medina: col. 11, lines 19-22].

Response to Arguments

Applicant's arguments with respect to claims 41-43 and 48-66 filed on

03/23/2005 have been considered but are moot in view of the new ground(s) of

rejection.

Conclusion

To expedite the process of re-examination, the examiner requests that all future

correspondences in regard to overcoming prior art rejections or other issues (e.g. 35

U.S.C. 112) set forth by the Examiner prior to the office action, that applicant should

provide and link to the most specific page and line numbers of the disclosure where

best support is found (see 35 U.S.C. 132).

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure:

Wachi et al. (U.S. Patent No. 5,880,386) which discloses a musical information

processing system with automatic data transfer.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Susan Y. Chen whose telephone number is 571-272-

4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen
Examiner
Art Unit 2161

November 21, 2005

UYEN LE
PRIMARY EXAMINER